

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/883,507 Confirmation No.: 8695
Applicant : Jeffrey Bedell *et al.*
Filed : June 19, 2001
Title : REPORT SYSTEM AND METHOD USING PROMPT OBJECT
ABSTRACTION
TC/Art Unit : 2168
Examiner: : Greta Lee Robinson
Docket No. : 53470.003040
Customer No. : **21967**

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. No amendments are being filed with this request. Additionally, this request is being filed with a Notice of Appeal.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below.

This application was filed over six years ago on June 19, 2001. On April 5, 2004, an initial action was issued rejecting claims 1-23. Claims 7, 14, 20 and 23, were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to point out what is included or excluded by the claim language. Claims 1, 8 and 21 were rejected under 35 U.S.C. 101 as allegedly being directed to non-statutory matter. Claims 1, 3-5, 8, 10-12, 15, 17-18 and 21, were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No.

6,571,236 to Ruppelt. Claims 2, 6-7, 9, 13-44, 16, 19-20 and 22-23 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,571,236 to Ruppelt. The Applicants filed a response to the Office Action. In the response the Applicants amended the claims to clarify the matter addressed to overcome the U.S.C. 112, second paragraph rejections and to address the 35 U.S.C. 101 rejections by clarifying that the system and method claims were performed using a computer. The Applicants additionally presented arguments addressing the 35 U.S.C. 102(e) and 35 U.S.C. 103(a) rejections. On January 14, 2005 the Office issued a final rejection withdrawing the U.S.C. 112, second paragraph rejections and the 35 U.S.C. 101 rejections but maintaining the 35 U.S.C. 102(e) and 35 U.S.C. 103(a) rejections. The Applicants responded successfully overcoming the Ruppelt reference. On September 25, 2006, the Office issued a non-Final Office Action rejecting figure 3 of the drawings. The Office also rejected claims 1-7 under 35 U.S.C. 101, and claims 1-7 and 21-23 under 35 U.S.C. 112, second paragraph.¹ Applicants responded to the Office Action amending claims 1 and 21 to address the Office's 35 U.S.C. 112 rejections and the 35 U.S.C. 101 rejections. On April 10, 2007 the Office issued a Final Office Action. The Office withdrew its objection to figure 3, but issued the same objection against figures 13 and 16, alleging that they represent partial views. The Office maintained the 35 U.S.C. 101 rejection of claim 1-7 despite the amendment directly addressing the concern. The Office rejected claims 1-7 and 21-23 under 35 U.S.C. 112, second paragraph. Claims 1 and 21 were rejected under 35 U.S.C. 102 as allegedly anticipated by US Patent

¹ Applicants note that there were no amendments to the claims between the January 14, 2005 Final Office Action (withdrawing the U.S.C. 112, second paragraph rejections which included claims 7 and 23, and the 35 U.S.C. 101 rejections which included claim 1) and the September 25, 2006, non-Final Office Action (reasserting U.S.C. 112, second paragraph rejections against claims including claims 7 and 23 and reasserting U.S.C. 101 rejections against claim 1).

5,604,898 to Saijyo et al.. Claim 1 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claim 1 of copending Application No. 11/192,103.

The Applicants respectfully disagree with the allegation that Figures 13 and 16 represent partial views. Figure 13 depicts a diagram illustrating draft prompt resolution according to an embodiment of the present invention. When the description of Figure 13 is read in light of the specification, it is clear that Figure 13 is not a partial view. Thus the drawing objection to the alleged partial view does not apply. Similarly, Figure 16 illustrates objects used to manipulate prompts under different uses of the prompts according to an embodiment of the present invention. Again, when the description of Figure 16 is read in light of the specification, it is clear that Figure 16 does not represent a partial view. If the Office still believes that the objections to the figures are sustainable, the Applicants respectfully request clarification of the objection. Specifically, Applicants request suggested amendments to the drawings that would clarify that they are not partial views.

Regarding the provisional obviousness-type double patenting rejection of claim 1 as being allegedly unpatentable over claim 1 of copending Application No. 11/192,103, Applicants respectfully request that this rejection be held in abeyance until all other substantive issues in the present patent application have been resolved.

With respect to the Office's 35 U.S.C. 101 rejection of claims 1-7, Applicants respectfully disagree with the assertion that claim 1 is directed towards non-statutory material. The Office asserts that the body of the claim is directed to the creation of a resolution object. Claim 1 recites "A reporting system for creating a report ...comprising: a prompt object... the prompt object being used to define some or every aspect of a report definition; and a resolution

object for collecting an answer to a question of the prompt object for report creation ... wherein the resolution object is created and stored prior to the execution of a report.” With respect, the Applicants submit that a reporting system with prompt objects used to define aspects of report definition and resolution objections collecting answers for report creation is directed towards useful, tangible and concrete results.

With respect to the 35 U.S.C. 112, second paragraph rejection of claims 1 and 21 and their respective dependent claims, the Applicants assert that the scope of the subject matter embraced by the claims is clear. Regarding the limitation “defines some or every aspect of a report definition” of claim 1, the Applicants note that as stated in MPEP § 2173.04, breadth of a claim is not to be equated with indefiniteness. The Office further rejects claim 1 under 35 U.S.C. 112, second paragraph as allegedly being incomplete for missing essential elements. In particular the Office asserts “the body of the claim recites a resolution object is created and stored prior to the execution of the report, but is silent as to the creation of the report as recited in the preamble.” In support of the rejection, the Office Action references §2172.01 of the M.P.E.P. That section, however, clearly states that essential matter is matter which is described as such in the specification or in other statements of the record. Applicants respectfully traverse this rejection and submit that neither the specification of the application nor the record describe or disclose *any* feature or function as being *essential to the invention*. The Office does not indicate where the creation of the report are disclosed or described as being essential to the invention. Applicants respectfully submit that without such a showing, the pending indefiniteness rejection cannot be maintained. *See, e.g.,* M.P.E.P. § 2172.01

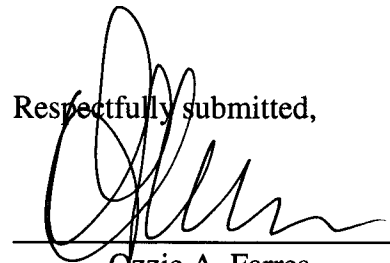
The Office Action rejected claims 1 and 21 under 35 U.S.C. 102(b) as being allegedly anticipated by U.S. Patent 5,604,898 to Saijyo et al. (“Saijyo”). Applicants respectfully disagree.

Anticipation requires that a prior art reference disclose, either expressly or under the principals of inherency, each and every element of the claimed invention. In re Sun, 31 USPQ2d 1451 (Fed. Cir. 1993). Saijyo fails to disclose at least “a prompt object comprising a question to be asked of a user and at least one validation property.” Figure 4, as cited by the Office, states that Saijyo’s invention contains “a relational database controlling portion for generating an enquiry object matching with the relational type database for the content to be processed by the relational type database to obtain an answer for that object.” Clearly an object processed by a relational type database to obtain an answer does not disclose “a prompt object comprising a question to be asked of a user.” Obtaining an answer from a relational database is not obtaining an answer from a user. Thus Saijyo fails to disclose at least this limitation of claims 1 and 21. Furthermore, the Saijyo also fails to disclose or suggest a validation property of a prompt object.

Because each and every limitation of the claims are not disclosed by Saijyo, the Office has clearly failed to meet its burden to show anticipation under section 102.

Thus, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by MicroStrategy when the grounds is so clearly improper.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ozzie A. Farres', is written over a horizontal line.

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